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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,919	03/02/2007	Gilles Voydeville	1759.221	8798
23405 7590 11/29/2010 HESLIN ROTHENBERG FARLEY & MESTI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203				
EXAMINER COTRONEO, STEVEN J				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
11/29/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/580,919

Applicant(s)

VOYDEVILLE, GILLES

Examiner

STEVEN J. COTRONEO

Art Unit

3733

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/12/2010 has been entered.

Election/Restrictions

Newly submitted claim 10 and 15-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 10 is directed to the method of inserting an implant. No prior claim referred to a method.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 10 and 15-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

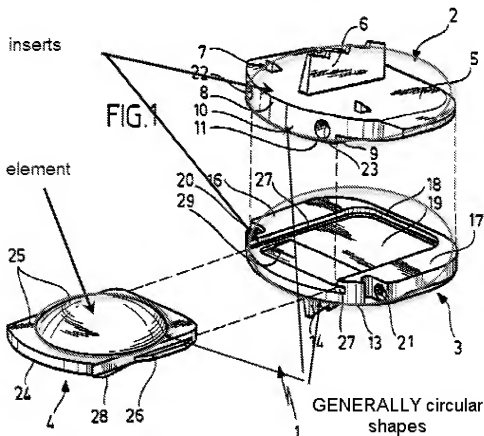
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnay et al. (WO 2001/01893 provided by the applicant) see US 6,936,071 for an English version.

Marnay et al. discloses a postero-lateral intervertebral disc prosthesis (see fig 1 below) having an element (fig 1, 4) mounted with an orientation and self-centering capability (fig 1, 28) between two inserts (fig 1, 2 and 3). The first insert (fig 1, 2) has a planar section fixed on the lower vertebral plateau (fig 1, 14). The element has a lower planar surface (fig 1, 24) for support, with a limited capacity for translational displacement on the first insert and an upper surface with a generally hemispherical form (fig 1, 25). The second insert has a planar section (fig 1, 6) fixed on the upper vertebral plateau and opposite thereto, a concave surface (fig 7, 11) for cooperating with the hemispherical surface of the element with the possibility of multi-directional articulation. The element is a core with a positioning stud (fig 1, 28). The core has coupling means to the first insert by a clipping means (fig 1, 26 in 27) and a pivot pin (fig 1, 28). The inserts have fittings (fig 1, 20-23) for gripping and handling means. The element has fittings to engage gripping means (edge 24). A retractor is used for insertion (col. 5, ll. 1-5, "spread apart... with aid of the manipulation instrument." i.e. instrument retracts and is capable of spreading the dural sac and roots). **The inserts are generally circular (the implant is round, see fig 1 below). The element is generally circular (see fig 1 below).**

Marnay et al. discloses the claimed invention except for the diameter being less than 30mm and the height being about 11-15mm. The Marnay device is for insertion in the vertebral space a diameter of 30mm would allow it to fit in the space. Marnay teaches minimizing the structural height of the implant to allow for easier insertion (col. 1, ll. 52-55) but does not specify the size. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the diameter less than 30mm and the height being about 11-15mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.



Response to Arguments

Applicant's arguments filed 10/12/2010 have been fully considered but they are not persuasive. The applicant argues that can not constitute a postero-lateral intervertebral disc prosthesis because of its size. The examiner respectfully disagrees. In response to applicant's argument that Marnay is not a postero-lateral implant, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the 103 rejection above the size of the implant is found to be an obvious variable to one of ordinary skill in the art. Since the prior art implant has a size within the range of the current application then it is capable to be inserted similarly i.e. postero-laterally.

The applicant also argues that the inserts do not have a **generally** circular shape. The examiner respectfully disagrees. Generally is defined by Merriam-Webster as "in a general manner" (see attached). Shown in Figure 1 above of Marnay a generally circular shape is disclosed. The inserts and element both generally match the circle added to the figure.

The rejections are deemed proper.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN J. COTRONEO whose telephone number is (571)270-7388. The examiner can normally be reached on M-F 730-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. J. C./
Examiner, Art Unit 3733

/EDUARDO C. ROBERT/
Supervisory Patent Examiner, Art Unit 3733